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09/858,174	05/15/2001	Martyn Ian Butterworth	13344-9025-00	1570
23409 7590 10/28/2008 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
JANVIER, JEAN D				
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3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/858,174

Applicant(s)

BUTTERWORTH, MARTYN IAN

Examiner

JEAN JANVIER

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 18-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No./Mail Date: ____

DETAILED ACTION

Claim Status

Claims 1-8 and 18-25 are currently being pending in the Instant Application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lederman, USP 5,448,625.

As per claims **1-8, 18 and 21-25**, Lederman discloses a method and apparatus for routing a telephone call through a telephone (telecommunication) network from a caller to a called party designated by the caller via advertising service apparatus that operates in two modes successively, the parties being in communication with each other in one mode and ads are selected from storage during that mode and the ads are impressed on one or both of the parties during a different mode. Selection of ad messages for use is controlled by many criteria. Delivery of ad is recorded for accounting purposes. The modes may alternate between message intervals whose duration is determined by ad message length and communication intervals whose length is determined by a talking time timer (See abstract).

The present system relates to telephone systems and to the dissemination of advertisements via telephone systems (col. 1: 8-9).

In general, communication between the parties (at least a caller and a call recipient) and the transmitted ad messages (supplemental images) may involve audio channels alone or they may involve video transmissions with the audio signals (Displaying a supplemental image or video on the caller's telecommunication apparatus or telephone-col. 21: 34-37).

Further, as one of the many criteria used in message selection, an **introductory** message of the ad service company is optionally inserted as the first (default or conventional) message on each call, to explain the interruptions to the called party (col. 3:56-60). In other words, an **introductory** ad service message, such as "Thank you for using . . . Advertising messages will occasionally interrupt your call . . .," is now played, optionally, to one or both of the parties before connecting the call (a default or conventional or untargeted message is played to one or both parties...col.7: 63-67).

In short, referring again to FIG. 2, prior to or during the time that the parties are connected, one or more ad messages in sponsored message storage 28d are selected by ad selector means 31d ("Ad Selector") in FIG. 6 using information stored in a delivery criteria database 28a located in the mass storage system 28 and the selected message or messages is placed into temporary storage in the central processing unit 31 in preparation for delivery. As part of the ad selection criteria, the first (default or conventional) message selected for delivery in each call is optionally an explanation of the advertisement dissemination system, similar to the **introductory** ad service message, e.g. "Thank you", as described above. (col. 8: 17-29).

(Col. 9: 66 to col. 10: 16; col. 15: 51-58).

See the entire reference.

As per claims 1 and 18, although Lederman teaches playing an initial/first (default or conventional) message (e.g. "Thank You") to the calling party and/or the called party via a telecommunication apparatus or telephone, however, Lederman does not expressly disclose displaying the supplemental image in addition to the conventional (first, initial, default, untargeted) message (e.g. "Calling", "Thank you") to the calling party.

However, it is common practice in the art to play/display a conventional message or status message, such as "Calling", "Dialing", "Thank you for using.....", "Welcome to...", the number currently being dialed and other relevant status messages based on the telecommunication service or provider, on a telecommunication apparatus or a telephone set used by a calling party or caller when the caller is trying to contact a called party or call recipient over the telecommunication service or system.

"Official Notice"

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the above disclosure ("Official Notice") into the system of Lederman so as to display a conventional (first, initial, default, untargeted) message (e.g. "Calling", "Thank you") or ad service message together with a supplemental image (advertisement) on a calling party telecommunication apparatus when the calling party is trying to contact a called party or call recipient over a telecommunication system, thereby seamlessly and simultaneously playing/displaying in real-time, via a telecommunication apparatus or a telephone handset used

by a calling party or caller when the caller is trying to contact a call recipient, a conventional message, i.e. "Dialing", "Welcome to...", the phone number currently being dialed, etc., or an advertisement introductory/first message, such as "Thank You", and a supplemental image (advertisement) during a first period of time before a connection is established between the caller and the call recipient and before the first time period expires, while preventing the caller from bypassing or ignoring the supplemental message (image) or advertisement since the caller has to look at the apparatus screen to make sure that the call is going through by checking the status of the call or the conventional or first message (e.g. "Dialing", "Calling", "Thank you", "Welcome to...", etc.) displayed thereon and while increasing the chance that the caller will pay attention to the supplemental image or advertisement presented thereon below the conventional message or introductory message, which in the end increases the effectiveness of the advertising system.

**Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Lederman, USP 5,448,625 in view of Gabbard, USP 6,205,432.**

As per claims 19 and 20, Lederman does not disclose that a caller or sender sends to the recipient a text message (or e-mail message) and the supplemental image is placed in the text or the text message.

However, Gabbard discloses an advertisement system and method for inserting into an end-user's communication message or e-mail a background reference to an advertisement. The background reference causes an advertisement image to be tiled or watermarked across an end-user screen behind the text of an e-mail message or public posting. A message server inserts the

background reference (ad) after receiving a message or an e-mail (text message) originally sent from an end-user originator (sender) and before sending the message to be delivered to an end-user recipient (recipient). When necessary, the message server will convert at least a portion of the message into a proper format, such as HTML, before inserting the background reference to an advertisement, which is preferably selected in accordance with end user recipient demographic information and/or ad exposure statistics. The advertisement itself, often a graphical file, is preferably not transmitted with the message, but is typically stored at the message server or other location remote from the end-user recipient. Preferably, the message server maintains and refers to records on each end-user recipient to allow for selective enablement of background reference insertion and overwriting based upon end user preferences. According to various "non-web" example embodiments, the message server transmits an SMTP, POP3 or NNTP message with an HTML portion for a respective HTML-compatible client. In other "web-based" example embodiments, the message server transmits the entire message in HTML to be used as a stand-alone web page or as a portion of a larger page employing frames or tables (see abstract). **(See Gabbard, USP 6,205,432)**

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the teachings of Gabbard into the system of Lederman so as to send by a sender/caller a text message or e-mail message to a recipient, via a communication apparatus or telecommunication system, wherein a server is configured to insert a targeted advertisement (supplementary image) into the text message or e-mail message before the text message or e-mail message is delivered or played/displayed to the called party or recipient, thereby taking advantage of a text message or e-mail message sent, by a sender/caller, to a recipient to present

to the recipient a targeted ad (supplementary image), based on the recipient's profile, inserted into the e-mail message before it is delivered to the recipient, while enabling the owner of the communication or telecommunication system to raise important funds or revenue by charging the advertiser, associated with the inserted targeted advertisement, a fee for presenting or displaying/playing his advertisement to the recipient of the sender's/caller's text message or e-mail.

Claims 1-8, 18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamel, USP 5,937, 037.

As per claims 1-8, 18 and 21-25, Kamel discloses a telecommunications system for delivering promotional messages (**supplemental images**) to subscribed calling parties (callers). In one configuration, the system includes an association processor for comparing preset targeting criteria of each promotional message with profile data of each subscribed calling party to obtain data associating each of the promotional messages with at least one subscribed calling party (providing targeted messages to a caller subscriber). In addition, a message queue having a plurality of electronic queues is provided, each of the electronic queues assigned to at least one subscribed calling party and storing the data associating each of the promotional messages with at least one subscribed calling party. A call processor operates off-line of the association processor and accesses an electronic queue assigned to a calling party and delivers to the calling party a promotional message according the data contained in the accessed electronic queue. In a preferred configuration, multiple queue types are provided having differing targeting precisions (See abstract; fig. 6A).

The present system generally relates to telephony and data communications networks, and in particular, the present system relates to an apparatus, which flexibly and efficiently delivers targeted promotional messages to end-user subscribers, preferably based on profiles, preferences and/or interests. **Herein, promotional messages include advertisements, public service announcements, surveys, and the like, delivered in audio, video and/or graphic formats (col. 1: 6-14).**

Kamel discloses a telecommunication systems for delivering messages to calling and called parties (recipients) including a local message bank having a plurality of electronic queues for storing data indicative of promotional messages therein and identifiable by calling party personal identification numbers; an interface unit, which receives a personal identification number from a calling party and retrieves and outputs to the calling party a promotional message indicated by the data contained in one of said plurality of electronic queues identified by the received personal identification number **(the promotional message is being relayed prior to or before the connection between the calling party and the called party or recipient or the promotional message, i.e. text, audio, video, or supplemental image is generated, communicated and stored prior to the connection between the calling party and the called party or recipient)**; and a central control facility for associating the promotional messages with subscribed calling parties off-line from the local message bank, and for downloading data indicative of the associations to the local message bank for storage of corresponding data in designated ones of said electronic queues (Col. 2: 44-60; col. 3: 9-25). Indeed, master message bank (MMB) 816 of fig. 8A receives beforehand, stores and maintains a copy of all messages (actual media clips/scripts) and their associated targeting parameters for all active campaigns.

Messages may be in the form of simple audio clips (i.e., for one-way delivery of audio messages), audio scripts (i.e., to include any interactive segments including information capture, cut-through triggers and numbers), text still and/or full motion graphic/video clips, and multi-media clips including any combination of audio, text graphic and video media (col. 15: 20-29; col. 19: 17-23).

According to yet another aspect of the present system, a method for **delivering promotional messages to calling and called parties in a telecommunication system** is provided and includes assembling and storing message data modules at a control module, each of said message data modules including at least a promotional message, at least one personal identification number associated with the promotional message, and delivery parameters associated with the promotional message; downloading the message data modules to a distribution module; transferring from the distribution module at least the promotional message of each message data module to at least one of plural electronic queues addressed by the personal identification number associated with the promotional message; **and processing a call by receiving a personal identification number from a calling party and retrieving and outputting to the calling and called parties a promotional message contained in a one of said plural electronic queues identified by the received personal identification number (col. 3: 27-45).**

Returning to FIG. 2, reference numeral 216 denotes a call processor, which retrieves the messages designated in the message queues 208 through **214 for delivery to the calling party 218 and/or the called party 222 via a telephone switching network 220**. It is noted that the call processor 216 and the association processor 206 can be implemented by physical distinct

processors, or a single processor having multitasking functions (col. 7: 7-19). Further, if a **message or message pointer is contained in a subscriber's or caller's individual queue, then the message is played or reproduced for the subscriber either before or after the subscriber or caller or calling party is connected to the called party or call recipient (step 506) of fig. 5A. If no such message exists (all individually associated messages meeting required criteria have been played), or no such associations have been established (NO at step 504), the system toggles to the next queue (category box) (figs. 5A and 5B; Col. 9: 27-50).**

As per claims 1 and 18, Kamel does not expressly disclose displaying the supplemental image (advertisement) in addition to the conventional (first, initial, default, untargeted) message (e.g. "Calling", "Thank you", "Dialing") to the calling party.

However, it is common practice in the art to play/display a conventional message or status message, such as "Calling", "Dialing", "Thank you for using.....", "Welcome to...", the number currently being dialed and other relevant status messages based on the telecommunication service or provider, on a telecommunication apparatus or a telephone set used by a calling party or caller when the caller is trying to contact a called party or call recipient over the telecommunication service or system.

"Official Notice"

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the above disclosure ("Official Notice") into the system of Kamel so as to display a conventional (first, initial, default, untargeted) message (e.g. "Calling", "Thank you") together with a supplemental image (advertisement) on a calling party telecommunication apparatus when the calling party is trying to contact a called party or call recipient over a

telecommunication system, thereby seamlessly and simultaneously playing/displaying in real-time, via a telecommunication apparatus or a telephone handset used by a calling party or caller when the caller is trying to contact a call recipient, a conventional message, i.e. "Dialing", "Welcome to...", "Thank you", the phone number currently being dialed, etc., and a supplemental image (advertisement) during a first period of time before a connection is established between the caller and the call recipient and before the first time period expires, while preventing the caller from bypassing or ignoring the supplemental message (image) or advertisement since the caller has to look at the apparatus screen to make sure that the call is going through by checking the status of the call or the conventional or first message (e.g. "Dialing", "Calling", "Thank you", "Welcome to...", etc.) displayed thereon and while increasing the chance that the caller will pay attention to the supplemental image or advertisement presented thereon below the conventional message or introductory message, which in the end increases the effectiveness of the advertising system.

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As per claims 19-20, Kamel does not disclose that a caller or sender sends a text message (or e-mail message) and the supplemental image (ad) is placed in the text or the text message to the recipient.

However, Gabbard discloses an advertisement system and method for inserting into an end-user's communication message or e-mail a background reference to an advertisement. The

background reference causes an advertisement image to be tiled or watermarked across an end-user screen behind the text of an **e-mail** message or public posting. A message server inserts the background reference (ad) after receiving a message or an e-mail (text message) originally sent from an end-user originator (sender) and before sending the message to be delivered to an end-user recipient (recipient). When necessary, the message server will convert at least a portion of the message into a proper format, such as HTML, before inserting the background reference to an advertisement, which is preferably selected in accordance with end user recipient demographic information and/or ad exposure statistics. The advertisement itself, often a graphical file, is preferably not transmitted with the message, but is typically stored at the message server or other location remote from the end-user recipient. Preferably, the message server maintains and refers to records on each end-user recipient to allow for selective enablement of background reference insertion and overwriting based upon end user preferences. According to various "non-web" example embodiments, the message server transmits an SMTP, POP3 or NNTP message with an HTML portion for a respective HTML-compatible client. In other "web-based" example embodiments, the message server transmits the entire message in HTML to be used as a stand-alone web page or as a portion of a larger page employing frames or tables (see abstract).

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the teachings of Gabbard into the system of Kamel so as to send by a sender/caller a text message or e-mail message to a recipient, via a communication or telecommunication system, wherein a server is configured to insert a targeted advertisement (supplementary image) into the text message or e-mail message before the text message or e-mail

message is delivered or played/displayed to the caller or recipient, thereby taking advantage of a text message or e-mail message sent, by a sender/caller, to a recipient to present to the recipient a targeted ad (supplementary image), based on the recipient's profile, inserted into the e-mail message before it is delivered to the recipient, while enabling the owner of the communication or telecommunication system to raise important funds or revenue by charging the advertiser, associated with the inserted targeted advertisement, a fee for presenting or displaying/playing his advertisement to the recipient of the sender's/caller's text message or e-mail.

Response to Applicant's Arguments

Applicant's arguments with respect to claims 1 and 18 have been considered but are moot in view of the new ground(s) of rejection. The amendment to the claims calls for "displaying a supplemental image and a conventional connection message on the caller's telecommunication device" and the amendment is addressed in the above Action.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not persuasive and thus, the current **Office Action has been made Final**.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

USP 5,652, 784 to Blen discloses a telephone advertising service for providing a short advertising message through a telephone receiver as a telephone call is initiated. The advertising message is stopped after a predetermined run time, and an invitation-to-dial tone is added. The advertising message is stopped when a subscriber starts to dial numbers. The method provides the advertising messages in lieu of invitation-to-dial tones. Differentiated subscribers are individually provided with distinct advertising messages. Subscribers are distinguished by characteristics of exchange number, monthly call volume, call type, geographical location and time of day. The advertising messages are provided by a message system rack connected to a digital or analog telephone exchange. Each rack has plural message recorders and plural cards connected to multiple users. Software controls a connection network. Subscriber lines are sampled to sense when a call is being initiated and to signal to a controller that a telephone call is being initiated. A PCM audio interface is activated. An available message channel is switched to the subscriber line, and a corresponding message is played over the subscriber line. Soon the subscriber line is connected to the telephone exchange, and an invitation-to-dial tone is provided.

Several different messages are offered in different sets of channels, changing the messages depending on the time of day. When a prohibit service signal is active, the subscriber line is switched directly to the telephone exchange (See abstract).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

10/22/08

/J. J./

/Jean Janvier/

Primary Examiner, Art Unit 3688